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JUN 03 2011

OFFICE OF PETITIONS

In re Patent of Mezzalira :
Patent No. 6,199,594 :
Issue Date: March 13, 2001 : Decision on Petition
Application No. 09/367,519 :
Filing Date: August 14, 1999 :
Attorney Docket No. 08MAR111 :

This is a decision on the "Petition to Add Inventor" filed by Attorney Richard Tushin on February 16, 2011, which is being treated as a petition to add an inventor pursuant to 37 C.F.R. § 1.324 and a petition under 37 C.F.R. 1.183 requesting waiver of 37 C.F.R. § 1.324(b)(2).

The petition under 37 C.F.R. § 1.324 is dismissed.

The petition under 37 C.F.R. § 1.183 is dismissed.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.324 and 37 C.F.R. § 1.183."

The sole inventor of record is Rinaldo Mezzalira.

Petitioner seeks to add Valentino Vigolo as an inventor.

37 C.F.R. § 1.324 states,

- (a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Commissioner may, on petition, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 1.634.

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- (b) Any petition pursuant to paragraph (a) of this section must be accompanied by:
- (1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;
 - (2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;
 - (3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and
 - (4) The fee set forth in § 1.20(b).

The petition does not include a statement from Mezzalira agreeing to the change of inventorship or stating he has no disagreement with regard to the requested change of inventorship. Therefore, the requirement set forth in 37 C.F.R. § 1.324(b)(2) has not been satisfied.

Petitioner requests the requirement for a statement from Mezzalira “be waived because he has died.” The request for waiver of the requirement for statement from Mezzalira is being treated as a petition under 37 C.F.R. § 1.183 requesting waiver of the requirement under 37 C.F.R. § 1.324(b)(2) for a statement from each inventor, excluding any inventor(s) being added or deleted, which agrees to the change of inventorship or states the inventor has no disagreement with the change of inventorship.

37 C.F.R. § 1.183 only provides the Office with the authority to waive a requirement “which is not a requirement of the statutes.” In other words, the Office does not have the authority to waive a statutory requirement.

35 U.S.C. § 256 states, with emphasis added,

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, *on application of all the parties and assignees*, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

M.P.E.P. § 1481.02 addresses the impact 35 U.S.C. § 256 has on the Office’s ability to waive requirements set forth in 37 C.F.R. § 1.324. M.P.E.P. § 1481.02 states, with emphasis added,

The statutory basis for correction of inventorship in a patent under 37 CFR 1.324 is 35 U.S.C. 256. It is important to recognize that 35 U.S.C. 256 is stricter than 35 U.S.C. 116, the statutory basis for corrections of inventorship in applications under 37 CFR 1.48. 35 U.S.C. 256 requires “*on application of all the parties and assignees*,” while 35 U.S.C. 116 does not have the same requirement. Under 35 U.S.C. 116 and 37 CFR 1.48, waiver requests under 37 CFR 1.183 may be submitted (see, e.g., MPEP § 201.03, under the

heading "Statement of Lack of Deceptive Intention"). This is not possible under 35 U.S.C. 256 and 37 CFR 1.324. In correction of inventorship in a nonprovisional application under 37 CFR 1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 CFR 1.183; however, *correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties*, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. 256) and thus the *requirement cannot be waived*.

As recognized in M.P.E.P. § 1481.02, the requirement for a statement from each inventor is a statutory requirement. Therefore, the Office cannot waive the requirement for a statement from Mezzalira and the petition under 37 C.F.R. § 1.183 is dismissed.

A statement from Mezzalira has not been filed and the requirement for a statement from Mezzalira has not been waived. Therefore, the petition under 37 C.F.R. § 1.324 is dismissed.

Petitioner may wish to note a reissue application can be used to correct an inventorship error. As stated in M.P.E.P. § 1481.02,

If an inventor is not available, or refuses, to submit a statement, the assignee of the patent may wish to consider filing a reissue application to correct inventorship, because the inventor's statement is not required for a non-broadening reissue application to correct inventorship. See MPEP § 1412.04.

The \$130 fee for the petition under 37 C.F.R. § 1.324 and the \$400 fee for the petition under 37 C.F.R. § 1.183 have been charged to Deposit Account No. 04-2223 pursuant to the general fee authorization set forth in the petition.

The petition is signed by Attorney Richard Tushin. The record fails to indicate Attorney Tushin has been given a power of attorney and the address on the petition is different than the address of record. While a courtesy copy of this decision is being mailed to Attorney Tushin at the address set forth on the petition, all future correspondence will be directed solely to the address of record absent receipt of appropriate instructions to the contrary.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.¹ Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

¹ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Anthony Knight
Director
Office of Petitions

cc: Richard Tushin
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